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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/298,889	04/26/1999	RAVI GANESAN	33500-030	2552

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EXAMINER

GORT, ELAINE L

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/298,889

Applicant(s)

GANESAN, RAVI

Examiner

Elaine Gort

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8,12-14,17,22,23,26,27 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,8,12-14,17,22,23,26,27 and 29-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7, 8, 12, 13, 14, 17, 22, 23, 26, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear in claim 7 lines 7 and 8, and claim 14 lines 9 and 10, what the difference is between the instruction to make payment and the instruction to transmit the directive to transfer funds. This appears redundant as the directive to transfer funds inherently includes the payment of a bill, and vice versa. Payment inherently includes a transfer of funds. It is unclear what additional limitation is being added by stating both.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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4. Claims 7, 8, 12, 13, 14, 17, 22, 23, 26, 27 and 29-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al. (US Patent 5,884,288).

Chang et al. discloses the claimed electronic bill payment system and network.

Chang et al. discloses:

a communications network (such as communication network shown in figure 2 including the internet);

Network stations capable of transmitting instructions to pay bills and to view remittance information (such as network stations shown as 202 and 208);

Wherein payers and payees have associated payment accounts and deposit accounts maintained at a plurality of financial institutions (206, see also column 5, lines 10+);

A processor/central network station (such as including all processors **excluding** the payee and payor's terminals disclosed. Including the internet, all central stations for all payers and payee's banks, settlement processor, payee's own accounts receivable processing system, and payee's system receiving and saving the check envelopes prior to payee opening them at their station, 232, 234, 236, 238 and 206);

Where the processor is configured to receive instructions from payors to make a payment of a bill (processors are capable of receiving instruction from a payor authorizing payment of a bill, such as described in column 7, lines 19+); transmitting a directive to transfer funds (such as when the settlement processor transmits a directive to transfer funds after a payee generates an electronic deposit, such as shown in column 10 lines 7+); and to generate remittance information associated with payment of

the bill (the processor generates remittance information which includes information such as amount paid, payment date, payor's account number and information, payee's account information, timestamp of the transmission, digital signatures, etc...);

A central database configured to store the remittance information so as to be accessible to the payee via the payee's user station (remittance information discussed above is stored in databases including the database where the check envelope is saved prior to payee accessing it from their terminal for deposit. Remittance information is also stored in the payee's own account receivable processing system and the payee's bank to document transactions. Payee has access to all these databases in order to obtain account history records);

Wherein the processor is configured to transmit the directive only after the receipt of the request to access the remittance information (the settlement processor transmits the directive to settle the transaction only after the payee accesses the check envelopes which contain "remittance" information stored in a database); and

Where the remittance information includes different information segments (such as the remittance information stored in the check envelope, payee's accounts receivable, and bank account databases includes different types of information associated with the payment of bills to different payees, as previously discussed) and is stored and accessible by payees via payee stations (information relating to payments is accessible to payees from their terminals).

All other claimed limitations are disclosed or inherent.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. In the alternative, claims 7, 8, 12, 13, 14, 17, 22, 23, 26, 27 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al.

Chang et al. discloses the claimed invention but is silent regarding the structure of the companies performing the billing, such as the number of user stations each payee has, how customer accounts are stored and accessed, and how they are configured. The use of internal network systems within a company which includes networked P.C.s and servers containing accounting data providing access to accounting and payment records on a company server via either an Intranet or the Internet is old and well known in the art of networking to allow multiple users with the ability to perform the same activities such as update accounting records. The use of more than one deposit account is old and well known in the art of accounting to track income relating to different internal businesses or operations carried out by the same company. An example of this is the tracking of income from services and income from products which generally require independent accounting due to differing tax implications along with the desire of companies to understand the differences in the two internal businesses. It would have been obvious to one having ordinary skill in the art at the time the invention

was made to provide the bill payment system of Chang et al. with payee companies employing internally networked stations with a company server accessible thru the Internet or Intranet and utilizing various deposit accounts, in order to allow more than one employee to perform the same activities and track incomes from different income streams.

Response to Arguments

7. Applicant's arguments filed 6/13/03 have been fully considered but they are not persuasive.

Applicant has traversed Examiners 35 USC 112 rejection relating to claims 7, 8, 12, 13, 14, 17, 22, 23, 26, and 27 stating that the language is unambiguous by stating that the recital of both an instruction to make payment and a directive to transfer funds is not redundant. Applicant further states that a directive to transfer funds does not inherently include payment of a bill. Examiner maintains that "payment" inherently includes a transfer of funds and therefore it is unclear what limitations are being claimed in regard to the instruction to make payment and the additional instruction to transmit a directive to transfer funds. It appears that the directive to transfer funds would be incorporated within the instructions to make a payment of a bill.

Examiner reviewed the page referred to in the specification, page 10, beginning on line 16 and notes that the specification discloses the central station capable of receiving an instruction to pay a bill, but not receiving an ***instruction*** to transmit a directive to transfer funds. As far as the Examiner can ascertain, the specification

discloses the central station being capable of generating a directive to transfer funds in accordance with the received instruction to pay a bill but makes not positive recitation of receiving an instruction to transmit a directive to transfer funds.

This rejection could be overcome by including language such as "upon receipt of the instruction the processor is configured" in line 10 of claim 7 just before the words "to transmit a directive to transfer funds".

See above rejection regarding clarification for all other arguments.

Examiner believes that potential areas of clarification leading to an allowance may exist and invites Applicant to an in-person interview to further discuss any potential areas.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703)308-5183. The fax phone number for the organization where this application or processing is assigned is (703)305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

EG



July 16, 2003

 7/17/03

ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
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